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EXAMINER

RETTA, YEHDEGA

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/922,425
Filing Date: August 03, 2001
Appellant(s): MITTMAN ET AL.

David A. Belasco
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed June 26, 2006 appealing from the Office action mailed November 22, 2005. Additionally, this is in response to the Director ordered remand under 37 CFR 41.35© from the Board of Patent Appeals and Interferences mailed 5/26/10.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct with the addition of the New Ground of Rejection discussed below:

NEW GROUND(S) OF REJECTION

Claim(s) 1-8 are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,665,715	HOURI	12-2003
6,792,458	MURET ET AL.	11-2004

“Intel’s Pentium II gets \$20 mil intro (Intel launching Pentium II microprocessor worldwide on 5/7/97 backed by \$20 mil ad campaign)” Advertising Age, v68, n18, p16, May 5, 1997,

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Intel’s Pentium II gets \$20 mil intro (Intel launching Pentium II microprocessor worldwide on 5/7/97 backed by \$20 mil ad campaign)” Advertising Age, v68, n18, p16, May 5, 1997, (hereinafter Advertising Age), in view of Houri U.S. Patent No. 6,665,715 and further in view of Muret et al. U. S. Patent No. 6,792,458.

Regarding claim 1 Advertising age teaches advertising media purchase placed in either of movies, video, television, print, etc., said media purchase including an Internet website address for accessing further information related to the subject matter of the media purchase, start data, end data and geographic area for the plurality of media purchases and

Art Unit: 3622

tracking the Internet-related goals achieved by the Internet user (accessing the website) (see page 1). Advertising age teaches the company launching an ad with a three days schedule in New York time, USA Today, The Wall Street Journal and handful of major metro papers. Page ads and spreads, starting May 19 in business magazines and computer publication. Advertising age teaches the company using one web address in print ads and another in banner ads to measure the effectiveness of each medium in driving the traffic to the site. Advertising age failed to teach means for determining the geographic location associated with an Internet protocol address, means for grouping the geographic location into uniform stated geographic area, means for inputting and maintaining records in the database. Houri teaches means for determining the geographic location associated with IP address, grouping the geographic location into uniform stated geographic area, and a first database for storing IP address and corresponding geographic location, means for inputting and maintaining records in the database, means for accessing the database and assigning a stated geographic area. Houri teaches location tracking system used in a situation where a website can provide appropriate information corresponding to the geographic location of the user visiting the site and providing reports illustrating the geographic dispersion of the website clientele, the report being accessible both on-line or on printable format (see abstract, fig. 2, 6-9, col. 1 line 30 to col. 2 line 41, col. 3 lines 9-40, col. 7 lines 27-58, col. 8 line 50 to col. 9 line 3, and col. 13 line 27 to col. 14 line 42). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention was made to adapt tracking system as in Houri in Advertising Age's website and determine the geographical location of the users and correlate to stated geographic area and store the information in a system data base in order to provide the advantage taught by Houri, such as track the rate of responses to their advertisement and/or content and to improve marketing and provide relevant

Art Unit: 3622

information corresponding to that geographical location (see col. 1 lines 40-54 and col. 13 line 4 to col. 14 line 42). Advertising Age teaches running ads for specific days (three-day ad schedule), plurality of geographic location (plurality of publications), use of web address on the ads and measuring the effectiveness of the each medium in driving traffic to the site, i.e., tracking Internet-related goals (accessing the web site) achieved by the Internet user related to his accessing the Internet website, however does not explicitly teach inputting the timing of occurrences of the Internet-related goals (user accessing the site). Muret teaches tracking web related goals and correlating and reporting the timing of Internet related goals, and providing report of activities of specific time period (see col. 1 line 45 to col. 2 line 32, col. 5 line 1 to col. 6 line 27 col. 7 line 4-15, col. 22 lines 5-60, col. 32 lines 56-68). It also would have been obvious to one of ordinary skill in the art at the time of the invention to implement tracking the timing of Internet-related goals as Muret, in Advertising Age's system (measuring effectiveness of ads that lead to a website), in order to track user's navigation within the website. One would be motivated to track the timing of the internet-goal in order to quickly assess which visitors are responsible for corresponding web server traffic and for advertiser to track how effective the banner ads are, and the location and behavior of shoppers, as taught by Muret (see col. 22 lines 28-34 and col. 23 line 49 to col. 24 lines 33).

Regarding claims 2-8, Advertising Age does not teach report comprising a media type, media name stated geographic area, compiled continuously from start date to end date, and residual period, summary of Internet traffics summary of Internet-related goals, wherein the Internet goals comprise sales, downloads, etc., graphical representation, etc, it is taught in Muret (see col. 12 lines 45-62, col. 19 lines 28-55, col. 23 lines 5-63, col. 26 line 23 to col. 29 line 29). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide such report, as taught in Muret in order to provide

Art Unit: 3622

advertisers detailed or specific or summarized report, or report with a "date range", etc, depending on the report chosen by the advertiser or website owner in order to make valuable business decisions, as taught by Muret (see col. 21 line 16 to col. 23 line 41).

NEW GROUND(S) OF REJECTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 1-8 are rejected under 35 USC § 112, ¶ 2, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the following means (or step) plus function limitations:

means for inputting and maintaining records in said first database

means for determining the geographic location associated with an Internet Protocol address

means for grouping said geographic locations into uniform stated geographic areas

means for determining the Internet Protocol address of an Internet user accessing said Internet website address

means for tracking the timing of Internet-related goals achieved by said Internet user related to his accessing said Internet website address

means for accessing said second database and assigning a stated geographic area to said user's Internet-related goal

means for correlating and reporting the timing of Internet-related goals achieved by said Internet user with the start date, end date and a residual period for media purchases within said stated geographic area

These limitations invoke 35 USC § 112, ¶ 6 because they meet the 3-prong analysis set forth in MPEP 2181 as it recites the phrase “means for” or “step for” (or appellant identifies the limitation as a means (or step) plus function limitation in the appeal brief) and the phrase is modified by functional language and it is not modified by sufficient structure, material, or acts for performing the recited function. Also see *Altiris Inc. v. Semantec Corp.*, 318 F.3d 1363, 1375 (Fed. Cir. 2003). 35 USC § 112, ¶ 6, requires such claim to be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. “If one employs means plus function language in a claim, one must set forth in the specification an adequate disclosure showing what is meant by that language. If an applicant fails to set forth an adequate disclosure, the applicant has in effect failed to particularly point out and distinctly claim the invention as required by the second paragraph of section § 112.” *In re Donaldson Co.*, 16 F.3d 1189, 1195, 29 USPQ 1845, 1850 (Fed. Cir. 1994)(in banc.). For a computer-implemented means-plus-function claim limitation that invokes 35 USC § 112, ¶ 6, the corresponding structure is required to be more than simply a general purpose computer. *Aristocrat Technologies, Inc. v. International Game Technology*, 521 F.3d 1328, 1333, 86 USPQ2d 1235, 1239-40 (Fed. Cir. 2008). The corresponding structure for a computer-implemented function must include the algorithm as well as the general purpose computer. *WMS Gaming, Inc. v. International Game Technology*, 184 F.3d 1339, 51 USPQ2d 1385 (Fed. Cir. 1999). The written description must at least disclose the algorithm that transforms the general purpose microprocessor to a special purpose computer programmed to perform the claimed function. *Aristocrat*, 521 F.3d at 1338, 86 USPQ2d at 1242.

In the instant application, the following portions of the specification and drawings may appear to describe the corresponding structure for performing the claimed function:

Figures 1-4 and pages 9 and 10.

However, the specification and drawings do not disclose sufficient corresponding structure, material or acts for performing the claimed function. It appears the claimed means are broadly defined on pages 9 and 10 of the specification and broadly shown in Figs. 1-4. However the specification does not specifically describe how the recited function is performed. Specifically, the specification does not disclose one or more specific algorithms for implementing the claimed means on a machine. Therefore, Appellants have failed to adequately describe sufficient structure for performing the claimed means.

(10) Response to Argument

Appellant's argument in the Appeal Brief is related to the teaching of correlating and reporting the timing of the Internet-related goals achieved by the Internet user with the start date, end date and **a residual period**. Examiner respectively disagrees. Examiner would like to point the Appellant to Muret's disclosure which discloses monitoring user activity at a web site at any time, in real-time. Muret teaches providing report on who visited the website, whether the visitor is new or existing visitor, the length of the visit, which web pages were viewed including the specific path the visitor took through the web site etc. (see fig. 23-25, the report includes date and time) to monitor marketing strategies and ad campaign effectiveness (see col. 21 lines 25-29). Muret specifically teaches using the visitor monitor report (see fig. 22 and col. 22 lines 5-25) the user (administrator) can click within the graph, within one of the rectangles, and the rectangle is mapped to a specific point in time and the time information is then compiled into a URL query and sent to the server to provide

Art Unit: 3622

information on that specific point in time. Further Muret teaches (see fig. 27-35) providing report on any time range (for example between 7/3/2000 and 7/9/2000). Since Muret provides report for any specific time and since the end user selects the time period any end user will be able to monitor the website (for Internet related goals), i.e., the specific time would include time period before the promotion (media purchase), during the promotional time (start and end date) and after the promotion ends (residual period). For example if the media purchase was for 3 days as taught in advertising age, the end user would select a 4, 5 or 7 day report, as taught in Muret.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

YR
/Yehdega Retta/
Primary Examiner, Art Unit 3622

Conferees:

Eric Stamber/E. W. S./
Supervisory Patent Examiner, Art Unit 3622

Vincent Millin /vm/
Appeals Conference Specialist

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/Wynn W. Coggins/
Director, TC 3600